

REMARKS / ARGUMENTS

The present application includes pending claims 1-18, all of which have been rejected. By this Amendment, claims 1-18 have been amended, as set forth above, to further clarify the language used in these claims and to further prosecution of the present application. The Applicant respectfully submits that the claims define patentable subject matter.

Initially, the Applicant notes that a goal of patent examination is to provide a prompt and complete examination of a patent application.

It is essential that patent applicants obtain a prompt yet complete examination of their applications. Under the principles of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the *initial review* of the application, even if one or more claims are found to be deficient with respect to some statutory requirement. Thus, Office personnel *should state all* reasons and bases for rejecting claims in the *first* Office action. Deficiencies should be explained clearly, particularly when they serve as a basis for a rejection. Whenever practicable, Office personnel should indicate how rejections may be overcome and how problems may be resolved. A failure to follow this approach can lead to unnecessary delays in the prosecution of the application.

See Manual of Patent Examining Procedure (MPEP) § 2106(II). As such, the Applicant assumes, based on the goals of patent examination noted above, that the present Office Action has set forth "all reasons and bases" for rejecting the claims.

Claims 1, 3, 7, 9, 13 and 15 were objected to because of informality. The Applicants have amended claims 1, 3, 7, 9, 13 and 15 as set forth above to overcome this informality.

Claims 1-12 stand rejected under 35 U.S.C. § 101 because the claimed invention is allegedly directed to non-statutory subject matter. Claims 1-4, 7-9 and 13-16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,049,533, issued to Norman et al. (hereinafter, Norman), in view of U.S. Patent Publication No. 2004/0001467, issued to Cromer et al. (hereinafter, Cromer). Claims 5, 6, 11, 12, 17 and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Norman, in view of Cromer, and further in view of U.S. Patent No. 4,481,670, issued to Freeburg (hereinafter, Freeburg). The Applicant respectfully traverses these rejections at least for the reasons previously set forth during prosecution and at least based on the following remarks.

REJECTION UNDER 35 U.S.C. § 101

The Applicant first turns to the rejection of claims 1-12 under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

The Examiner states the following in the Office Action:

For claims 1 and 7, the claim falls within a statutory category and includes a judicial exception **but has no practical application.**

See the Office Action at page 3. The Examiner has conceded that Applicant's independent claims 1 and 7 fall within a statutory category. However, it appears that the Examiner is only challenging whether Applicant's claims 1 and 7 have practical application, i.e., whether Applicant's claims 1 and 7 produce useful, tangible and concrete result.

The Applicant respectfully asserts that the disclosed and claimed invention produces useful, tangible and concrete results. The Applicant's invention provides utility that is (i) specific, (ii) substantial and (iii) credible. See MPEP § 2107 and Fisher, 421 F.3d, 76 USPQ2d at 1230. **For example, each of claims 1-12 provides a practical application that produces a useful result, i.e., a method for providing communication in a hybrid wired/wireless local area network.** Furthermore, the Applicant's disclosed and claimed invention clearly does not fall in the category of the § 101 Judicial exceptions. Accordingly, there is no need for the Applicant to distinguish the disclosed and/or claimed subject matter from the three § 101 judicial exceptions to patentable subject matter by specifically reciting in the claim the practical application.

With regard to tangible results, the Applicant respectfully asserts that the disclosed and claimed invention recites more than a § 101 judicial exception and that the claims specifically set forth a practical application to produce a real-world result.

With regard to concrete results, since appropriate rejection under 35 U.S.C. § 101 should be accompanied by a lack of enablement rejection under 35 U.S.C. § 112, paragraph 1, in instances where the invention cannot operate as intended without undue experimentation. Since no such rejection was received, the Applicant assumes that the invention provides useful results. Notwithstanding, the Applicant respectfully asserts that the disclosed and claimed invention provides useful results and the results are repeatable and predictable.

The Applicant points out that the preambles of independent claims 1 and 7 specifically recite the utility of Applicant's claims, i.e., for providing communication in a hybrid wired/wireless local area network. At least for the above reasons, the Applicant believes that Claims 1-12 comprise patentable subject matter and are believed to be allowable.

The Examiner has stated that claims 1 and 7 have "no practical application". The Applicant respectfully disagrees. For example, claim 1 recites that status information of an access device is being requested, which is a useful, concrete and tangible result. Furthermore, the Examiner is referred to at least paragraphs 52-63 of the Specification for additional clarification as to how the status information is used for purposes of providing communication in a hybrid wired/wireless local area network.

Accordingly, the Applicant courteously requests that the rejection under 35 USC § 101 be withdrawn and each of Claims 1-12 be allowed. The Applicant reserves the right to argue additional reasons beyond those set forth above that support the allowability of all rejected claims.

REJECTION UNDER 35 U.S.C. § 103

In order for a *prima facie* case of obviousness to be established, the Manual of Patent Examining Procedure ("MPEP") states the following:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the teaching. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

See MPEP at § 2142, citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added). Further, MPEP § 2143.01 states that "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination," and that "although a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a *suggestion or motivation in the reference* to do so'" (citing *In re Mills*, 916 F.2d 680, 16 USPQ 2d 1430 (Fed. Cir. 1990)).

Moreover, MPEP § 2143.01 also states that the level of ordinary skill in the art cannot be relied upon to provide the suggestion...,” citing *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ 2d 1161 (Fed. Cir. 1999). Additionally, if a *prima facie* case of obviousness is not established, the Applicant is under no obligation to submit evidence of nonobviousness.

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

See MPEP at § 2142.

I. The Proposed Combination of Norman and Cromer Does Not Render Claims 1-4, 7-9 and 13-16 Unpatentable

The Applicant now turns to the rejection of claims 1-4, 7-9 and 13-16 as being unpatentable over Norman in view of Cromer.

A. Independent Claim 1

With regard to the rejection of independent claim 1 under 103(a), the Applicant submits that the combination of Norman and Cromer does not disclose or suggest at least the limitation of “requesting from said at least one of a plurality of access points, a status of said at least one access device located within said coverage area of said at least one of a plurality of access points,” as recited by the Applicant in independent claim 1.

With regard to Norman, the Office Action concedes the following:

Norman disclose all of the subject matter of the claimed invention except a requester (see Figure 2 Box 222, AP programmed to request) sending/requesting from the at least one of a plurality of access points, a status of the at least one access device located within a coverage area of the at least one of a plurality of access points and receiving from the at least one of a plurality of access points within whose coverage area the at least one access device is located, at least one status reply message indicating a status of the at least one of a plurality of access devices.

See the Office Action at page 4 (emphasis added). The Examiner then relies on Cromer and states the following:

The invention of Cromer from the same or similar fields of endeavor sending/requesting from the at least one of a plurality of access points, a status of the at least one access device located within a coverage area of the at least one of a plurality of access points (see paragraph 0043 lines 1-6) and receiving from the at least one of a plurality of access points within whose coverage area the at least one access device is located, at least one status reply message indicating a status of the at least one of a plurality of access devices (see paragraph 0043 lines 1-6).

See the Office Action at pages 4-5. The Examiner relies on Figure 7 and paragraph 0043 of Cromer. *Figure 7 of Cromer shows a flowchart of a program executed in the access point to manage client redistribution. More specifically, the program decides which client to attempt to redistribute. To make this determination, the access point executes an algorithm against each client in Table 500.* The algorithm is designed to identify which clients need to be moved to reduce aggregate bandwidth below the threshold. See Cromer at paragraph 0042. In other words, **paragraphs 0042 and 0043 of Cromer (relating to Figure 7)**

describe client redistribution, which is achieved by executing an algorithm against each client, without requesting by the access points status information for any of the clients (access devices).

The Examiner relies on paragraph 0043 of Cromer, which recites the following, in relevant portions:

From 704 the program descends into 706 whereat **a Request to Redistribute message is sent to adjacent access points. The message contains, among other things, the contents of Table 500 for the identified clients** or client. The program then descends into 708 where it waits for a response.

See Cromer at paragraph 0043 (emphasis added). Cromer simply discloses that a Request to Redistribute is being sent to adjacent access points, where the request contains table entries information from Table 500 (Figure 5). The Examiner is referred to Paragraph 0044, where Cromer discloses the following with regard to processing of the Request to Redistribute:

The program then descends into block 804 **when it does receive a request to redistribute. In 804 the program tests if it has extra capacity. This is done by checking the aggregate bandwidth 512 in Table 500 for that access point. If there is no additional bandwidth the request is denied in block 808.**

See Cromer at paragraph 0044 (emphasis added). Clearly, **the Request to Redistribute is not a request for status information for an access device or a client, as recited in Applicant's claim 1.** In this regard, when the Request to

Redistribute is received, the program **checks the aggregate bandwidth for the access point**, and a determination on whether or not to deny the request is made **based on the determined bandwidth of the access point**. Therefore, Cromer does not disclose or suggest that there is any requesting from an access point of status information of an access device (client) that is within a coverage area of the access point, as recited by the Applicant in claim 1.

As shown above, neither Norman nor Cromer teach or suggest "requesting from said at least one of a plurality of access points, a status of said at least one access device located within said coverage area of said at least one of a plurality of access points," as recited by the Applicant in independent claim 1. Accordingly, the proposed combination of Norman and Cromer does not render independent claim 1 unpatentable, and a *prima facie* case of obviousness has not been established. The Applicant submits that claim 1 is allowable.

Independent claims 7 and 13 are similar in many respects to the method disclosed in independent claim 1. Therefore, the Applicant submits that independent claims 7 and 13 are also allowable over the references cited in the Office Action at least for the reasons stated above with regard to claim 1.

B. Rejection of Dependent Claims 2-4, 8-10 and 14-16

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1, 7 and 13 under 35 U.S.C. § 103(a) as being unpatentable over Norman in view of Cromer has been overcome and requests that the rejection be withdrawn. Additionally, claims 2-4, 8-10 and 14-16 depend from independent claims 1, 7 and 13, respectively, and are, consequently, also respectfully submitted to be allowable.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 2-4, 8-10 and 14-16.

II. The Proposed Combination of Norman, Cromer and Freeburg Does Not Render Claims 5, 6, 11, 12, 17 and 18 Unpatentable

Since the additional cited reference (Freeburg) does not overcome the deficiencies of Norman and Cromer, claims 5, 6, 11, 12, 17 and 18 depend from independent claims 1, 7 and 13, respectively, and are, consequently, also respectfully submitted to be allowable at least for the reasons stated above with regard to allowability of claim 1. The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 5, 6, 11, 12, 17 and 18.

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CONCLUSION

Based on at least the foregoing, the Applicant believes that all claims 1-18 are in condition for allowance. If the Examiner disagrees, the Applicant respectfully requests a telephone interview, and requests that the Examiner telephone the undersigned Attorney at (312) 775-8176.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Ognyan Beremski', written over a horizontal line.

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